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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	85436615
Applicant	Mott's LLP
Applied for Mark	MOTT'S
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APP. SER. NO.: **85/436,615**	§	ATTY NO. 5338.4163
	§	
APPLICANT: MOTT'S LLP	§	EXAMINER: Thomas M. Manor
	§	
MARK: **MOTT'S**	§	FILING DATE: **September 30, 2011**

BRIEF FOR APPELLANT

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BRIEF FOR APPELLANT

Sir:

Pursuant to a Notice of Appeal and appeal fee filed with the Trademark Trial and Appeal Board on August 14, 2012, Applicant hereby timely appeals from the Examiner's final refusal to register the above-identified mark in Class 5, dated February 17, 2012 ("Final Rejection") and denial of Applicant's request for reconsideration, dated September 4, 2012 ("Denial of Reconsideration"), and respectfully requests that the Trademark Trial and Appeal Board reverse the Examiner's decision on the grounds that Applicant's Mark is not primarily merely a surname.

I. APPLICANT'S TRADEMARK

Applicant, Mott's LLP ("Applicant") seeks registration on the Principal Register of the mark MOTT'S ("Applicant's Mark" or the "Mark") for "Packaged combinations consisting primarily of fresh fruit, namely, fresh fruit and fresh fruit packaged in combination with cheese, granola, yogurt, and/or caramels," in International Class 31.

II. THE REJECTION

The Examiner refused registration of Applicant's Mark under 15 U.S.C. § 1052(e)(4) stating that the Mark is primarily merely a surname.

III. THE ISSUE

The issue presented by this appeal is whether Applicant's Mark is primarily merely a surname within the meaning of 15 U.S.C. § 1052(e)(4).

IV. THE ARGUMENT

A. Applicant's Mark is not primarily merely a surname.

The determination of whether a mark is primarily merely a surname depends on the mark's primary significance to the purchasing public. *See, e.g., Ex Parte Rivera Watch Corp*., 106 USPQ 145, 149 (Comm'r Pats. 1955). Applicant urges that the Mark is not primarily merely a surname under the three objective factors frequently used by the Trademark Trial and Appeal Board (the "TTAB" or "Board"). *See In re Benthin Management GmbH*, 37 USPQ2d 1332, 1333-1334 (TTAB 1995); TMEP § 1211.01.

1. The Mott surname is rare

One of the objective factors identified by the Board is whether the identified surname is itself rare. *See In re Benthin*, 37 USPQ2d 1332 (TTAB 1995) (the fact that BENTHIN was a rare surname found to be a factor weighing against a finding that the term would be perceived as primarily merely a surname); *In re Joint-Stock Co.*, 84 USPQ2d 1921 (TTAB 2007) (finding that rarity of BAIK weighed against surname refusal); *In re Sava Research Corp*., 32 USPQ2d 1380 (TTAB 1994) (SAVA not primarily merely a surname, where there was evidence that the term's use as a surname was rare); TMEP § 1211.01(a)(v).

a. U.S. Census Data

The term "MOTT" is uncommonly used as a surname. In the Office Action dated November 23, 2011 ("First Office Action") and the Final Rejection, the Examiner provided evidence in the form of search results from a nationwide telephone directory of names, which purport to show use of "MOTT" as a surname. *See* First Office Action at 2 and Final Rejection at 8. However, courts have found that such evidence is not determinative of the issue. *See In re Kahan & Weisz Jewelry Mfg. Corp.*, 508 F.2d 831, 832-833 (C.C.P.A. 1975). Much more persuasive are the records from the United States Census. TMEP § 1211.02(b)(iii) ("Because the [Census Data] database reflects the number of individuals, rather than the number of households, with a particular name, search results from this database may be more persuasive evidence of surname frequency than results from telephone directory listings.").

Applicant requests that the Board take notice of official United States Census Data (2000) concerning the commonality of surnames within the U.S. population. *See In re Spirits Int'l N.V.*, 86 U.S.P.Q.2d 1078, 1085 (T.T.A.B. 2008) (noting that the Board may take judicial notice of census data); *In re Tokutake Industry Co.*, 87 U.S.P.Q.2d 1697, 1700, n.1 (T.T.A.B. 2008) (taking judicial notice of census data cited in the examiner's brief); *In re R. L. Anderson, Inc.*, 2011 TTAB LEXIS 342, at *4-*5 (T.T.A.B. Sep. 30, 2011) (taking judicial notice of official United States Census Data (2000)). Specifically, Applicant requests that the Board take notice that the MOTT surname is ranked as the 1,941st most common surname in the 2000 Census, thereby making the MOTT surname relatively rare. U.S. Census Bureau, *Genealogy Data: Frequently Occurring Surnames from Census 2000, File B: Surnames Occurring 100 or More Times*, http://www.census.gov/genealogy/www/data/2000surnames (last visited Dec. 27, 2011).

In the Final Rejection, the Examiner noted that the aforementioned Census data was not made of record through the provision of electronic attachments and encouraged Applicant to use TEAS or regular mail to submit the Census data. In response, Applicant urged that the cited database comprises more than

six thousand pages of statistical surname data and therefore does not fall within the technical uploading capabilities of the TEAS system. Likewise, with respect to using regular mail, common sense weighs against depositing more than six thousand pages of statistical surname data to the Trademark Office, especially when the voluminous data is relied upon for one simple, verifiable and undisputed fact: that the MOTT surname is ranked as the 1,941st most common surname in the 2000 Census.

It should be noted that the Board, in its discretion, may take judicial notice of any relevant fact that is "not subject to reasonable dispute in that it is either (1) generally known within the territorial jurisdiction of the trial court or (2) capable of accurate and ready determination by resort to sources whose accuracy cannot reasonably be questioned." TBMP § 704.12(a). Additionally, the Board may take judicial notice of relevant facts presented at any stage of a Board proceeding, including facts presented in Applicant's brief. *See* TBMP § 704.12(b). Applicant urges that surname rankings provided by the official United States Census Data (2000) are relevant, not subject to reasonable dispute, generally known within the United States, and capable of accurate and ready determination. As such, Applicant requests the Board take judicial notice of the MOTT surname ranking, as well as other surname rankings discussed in this brief, namely, rankings for JOHNSON, MILLER, FORD, MCDONALD, FOX, KLEIN, and SEARS.

In the event that the Board decides not to take judicial notice of United States Census Data, Applicant has provided in its August 14, 2012 Request for Reconsideration, a screenshot of the U.S. Census Bureau website from which the referenced database was accessed, as well as a screenshots of the Microsoft Excel spreadsheet which references the surnames MOTT, JOHNSON, MILLER, FORD, MCDONALD, FOX, KLEIN, and SEARS. *See* Request for Reconsideration at **EXHIBIT A**. Applicant has included with this publicly available document the date on which the material was accessed and printed together with its source (URL). As such, Applicant requests, in the alternative, that this United States Census Data be accepted as Internet Material pursuant to TBMP § 704.08(b).

b. Rarer than other non-surname marks

The MOTT surname is also much rarer than numerous other "surname mark" families that have been granted broad protection, despite their more common surname usage. *E.g.*, U.S. Reg. No. 953,186 of JOHNSON & JOHNSON (surname JOHNSON having a statistical ranking of 2 in 2000 U.S. Census Data); U.S. Reg. No. 506,937 of MILLER (surname MILLER having a ranking of 6); U.S. Reg. No. 74,530 of FORD (surname FORD having a ranking of 124); U.S. Reg. No. 743,572 of MCDONALD'S (surname MCDONALD having a ranking of 127); U.S. Reg. No. 1,808,084 of FOX (surname FOX having a ranking of 167); U.S. Reg. No. 2,000,616 of CALVIN KLEIN (surname KLEIN having a ranking of 359); U.S. Reg. No. 1,529,006 of SEARS (surname SEARS having a ranking of 1019). Just as these other trademark families are afforded broad protection, Applicant's Mark deserves protection on the Principal Register without a §2(f) claim. *See* Request for Reconsideration at **EXHIBIT A**.

During a phone conference with the Examiner, the Examiner stated that §2(f) claims are often required, even with respect to well-known brand families, such as the FORD mark owned by the Ford Motor Company. Subsequent to this phone conference, Applicant further evaluated the FORD portfolio and discovered that §2(f) claims are exceptionally rare in that portfolio. Indeed, Applicant identified one hundred and ninety-six (196) separate FORD registrations, only one of which contains a §2(f) claim to acquired distinctiveness. (*See* Request for Reconsideration at **EXHIBIT D** for a list of 196 FORD registrations along with 37 representative registration certificates).

Turning back to the statistical surname data from the U.S. Census Bureau, it should be noted that while MOTT is the 1,941st most common surname in the 2000 Census, FORD is ranked 124th. (*See* Request for Reconsideration at **EXHIBIT A**). If we look instead at the relative surname ratio within the U.S. population, we find that for every "Mott"-surnamed person on the streets of America, there are ten "Fords." Roughly speaking, use of the term MOTT as a surname is therefore ten times rarer than use of the FORD surname. And yet, the Ford Motor Company has secured myriad FORD registrations without

a §2(f) claim to acquired distinctiveness. If the Ford Motor Company can register the trademark FORD without a §2(f) claim, and MOTT is a much rarer surname than FORD (by an order of magnitude), then Applicant should also be allowed to register its trademark without a §2(f) claim to acquired distinctiveness.

c. Examiner's evidence insufficient

As purported proof of common usage of the term MOTT as a surname, the Examiner provided printouts of an on-line whitepages database showing "100+ results" for the term "Mott Nationwide." Further, these purported "100+ results" can be broken down into state-by-state results, four of which have been provided by the Examiner:

- "Mott" Arkansas – 10 listings shown
- "Mott" in California – 9 listings shown
- "Mott" in Florida – 9 listings shown
- "Mott" in Kansas – 10 listings shown

See Final Rejection at 8-22. Again, Applicant urges that the records of the U.S. Census Bureau are much more persuasive than such telephone directories. *See* TMEP § 1211.02(b)(iii). Applicant has provided statistical evidence of surname use compiled by the U.S. Census Bureau which proves that the use of MOTT as a surname is relatively rare. Such evidence is routinely relied upon by the Board and Applicant urges that this evidence is much more authoritative and persuasive than on-line whitepages. *See* TMEP § 1211.02(b)(iii).

The Examiner also stated that "if a surname appears routinely in news reports, articles and other media as to be broadly exposed to the general public, then such surname is not rare…." Final Rejection at 4. The Examiner went on to provide the following examples of "news reports, articles and other media":

- *New Ruth Mott Foundation president hopes to bring her national, international experience to new position*
- *Bill Mott: it's game over for financial services*
- *Mott Foundation President Bill White says Genesee Towers should be torn down*
- *Touring the Underground Railroad in New Jersey*
- *Mott Wins Three to Highlight UNC Invitational*

See Final Rejection at 23-32, *citing* various news articles. Applicant notes that two of the cited articles reference charitable foundations in which the term MOTT is used as part of the respective foundation's trademark, *e.g.*, the Ruth Mott Foundation and the Charles Stewart Mott Foundation (referred to as the "Mott Foundation"). Indeed, the latter owns a published application for CHARLES STEWART MOTT FOUNDATION, which was accepted for publication *without* a §2(f) claim to acquired distinctiveness. (*See* Request for Reconsideration at **EXHIBIT B**). Additionally, the fourth article references a historic "Peter Mott House" in Lawnside, New Jersey that once formed part of the Underground Railroad. Again, this is not surname use, but rather reference to a historical, geographic place.

Of the articles cited by the Examiner in the Final Rejection, only two contain actual use of the term MOTT as a surname. The first appears to be a British publication referencing a British hedge fund manager, concerning the status of the British economy. Consequently, this article has no affect on the general public within the United States, and thus is irrelevant to the question of surname rarity. This leaves only a single article which references the term MOTT as a surname, namely, a blog post from a college newspaper recounting the track and field exploits of a number of athletes from the University of North Carolina, including one Elizabeth Mott. Applicant urges that this solitary article falls well short of proving that the term MOTT "appears routinely [as a surname] in news reports, articles and other media."

d. Examiner's new evidence is improper and should not be considered

In his Denial of Reconsideration the Examiner provides ten additional articles from the Internet purporting to show use of the term "MOTT" as primarily merely a surname. Applicant notes that pursuant to 37 C.F.R. § 2.142(d), the Board "will ordinarily not consider additional evidence filed with the Board by the appellant or by the examiner after the appeal is filed." Consequently, in view of Applicant's earlier-filed Notice of Appeal, Applicant urges that the ten Internet articles included in the Examiner's Denial of Reconsideration should be ignored in the subject action.

e. Examiner's new evidence insufficient

In the alternative, if the Board decides to consider the ten Internet articles included in the Examiner's Denial of Reconsideration, Applicant urges that this new evidence is also insufficient proof of surname significance. First, of the ten Internet articles provided in the Examiner's new evidence, one of the cited articles once again references a charitable foundation in which the term MOTT is used as part of the respective foundation's trademark, *e.g.*, the C.S. Mott Children's Hospital. Denial of Reconsideration at 24-30. Applicant again brings to the Board's attention the fact that this charitable foundation owns a published application for CHARLES STEWART MOTT FOUNDATION, which was accepted for publication *without* a §2(f) claim to acquired distinctiveness. (*See* Request for Reconsideration at **EXHIBIT B**). Applicant requests that its own trademark be given similar consideration.

With respect to the remaining Internet articles cited in the Examiner's new evidence, it should be noted that "the test is whether the primary significance of the term to the purchasing public is that of a surname." TMEP § 1211.01(a)(v). Applicant contends that the first Internet search conducted by the Examiner, the results of which were made of record in the Final Rejection at 23-32, is more indicative of the purchasing public's exposure to the term MOTT than the latest Internet search presented in the Examiner's new evidence. While that initial search revealed multiple uses of MOTT as a trademark, as a historic and geographic term, and even as a surname in a foreign jurisdiction, it provided only one,

obscure example of the surname use of MOTT in the form of a blog posting by a college newspaper. Similarly, the Internet articles provided in the Examiner's new evidence merely provide several obscure examples of surname use; none of which suggest that the purchasing public assigns primary surname significance to Applicant's mark.

2. No one connected with Applicant uses the Mott surname

The second objective factor considered by the TTAB is "whether the term is the surname of anyone connected with the applicant." *In re Benthin*, 37 USPQ2d 1332, 1333-1334 (TTAB 1995); TMEP § 1211.01(a)(iv). If a term identifies a historical person, rather than Applicant or Applicant's business partners, then the term may not be primarily merely a surname. *See Lucien Piccard Watch Corp. v. Since 1868 Crescent Corp.*, 314 F. Supp. 329, 165 USPQ 459 (S.D.N.Y. 1970) (DA VINCI found not primarily merely a surname because it primarily connotes Leonardo Da Vinci); *In re Pyro-Spectaculars, Inc.*, 63 USPQ2d 2022, 2024 (TTAB 2002) (SOUSA for fireworks and production of events and shows featuring pyrotechnics not primarily merely a surname, where the evidence showed present-day recognition and continuing fame of John Philip Sousa as a composer of patriotic music, and the applicant's goods and services were of a nature that "would be associated by potential purchasers with patriotic events such as the Fourth of July, patriotic figures, and patriotic music"); *Michael S. Sachs Inc. v. Cordon Art B.V.*, 56 USPQ2d 1132 (TTAB 2000) (primary significance of M. C. ESCHER is that of famous deceased Dutch artist).

The Mott Company was first "founded in 1842 by Samuel R. Mott in Bouckville, New York, where he made cider with the help of hitched horses that plodded in a circle, crushing apples between two large stone drums at the center of the 'sweep.'" (*See* Applicant's January 25, 2012 Office Action Response ("First Response") at **EXHIBIT A**). Over the past one hundred sixty-nine (169) years, Applicant's business has grown from those humble beginnings in upstate New York to become "the nation's leading producer of [MOTT'S] branded apple sauce and apple juice." (*See id*. at **EXHIBIT B**).

Consequently, no current individual with the surname MOTT is connected with Applicant's use of the MOTT'S Mark, the term identifies a well known historical figure, and the Mark is not primarily merely a surname.

The Examiner counters that "if the term would be evocative of numerous individuals rather than one particular historical individual, the term does not qualify as a historical name but is merely the surname of numerous individuals with varying degrees of historical significance." Final Rejection at 3. The Examiner goes on to provide the following examples of historical figures:

- Mott, Lucretia Coffin – American feminist and social reformer who was active in the antislavery movement and with Elzabeth Cady Stanton called the first convention for women's rights, held at Seneca Falls, New York (1848).

- Mott, John Raleigh – American religious leader. He shared the 1946 Nobel Peace Prize for his leadership of the YMCA.

See Final Rejection at 6-7, *citing the American Heritage Dictionary, Fourth Edition*. It is remarkable that in the past two hundred and thirty-six years of American heritage, the *American Heritage Dictionary* can recount only two persons, surnamed "Mott," which possess a sufficient measure of historical significance to warrant remembrance. Of course, this result should be expected given the rarity with which the term MOTT is used as a surname within the United States, as described by the Census Bureau. In any event, Applicant urges that the term MOTT does not evoke "numerous individuals with varying degrees of historical significance." Rather, the term MOTT identifies a historical person, Samuel R. Mott, rather than Applicant or Applicant's business partners, and the term is therefore not primarily merely a surname.

3. MOTT'S has recognized meaning other than as a surname

The third objective factor considered by the Board is "whether the term has any recognized meaning other than as a surname." *In re Benthin*, 37 USPQ2d 1332, 1333-1334 (TTAB 1995); TMEP § 1211.01(a). If a mark has a meaning or significance in addition to its significance as a surname, and thus creates a distinct commercial impression, the mark is not merely a surname. *See In re Isabella Fiore, LLC*, 75 USPQ2d 1564 (TTAB 2005); *In re United Distillers plc*, 56 USPQ2d 1220 (TTAB 2000); TMEP § 1211.

Applicant urges that MOTT'S is not primarily merely a surname because the term has significance in its reference to a historical person. In particular, Applicant's Mark immediately identifies the historical figure Samuel R. Mott, who is so widely recognized, revered, and celebrated that use of the term MOTT'S has lost any surname significance. As noted above, the Mott Company was first founded more than one hundred sixty-nine (169) years ago by Samuel R. Mott in Bouckville, New York, whose innovations relating to apple-based food and beverage products have become legendary. Samuel R. Mott practically invented the modern applesauce business and today the company he founded is "the nation's leading producer of [MOTT'S] branded apple sauce and apple juice." (*See* First Response at **EXHIBITS A-B**). This same historical significance translates to use of the Mark in connection with packaged combinations containing fresh fruit, including apples.

Consumers of Applicant's goods will instantly recognize the term MOTT'S as referring to Samuel R. Mott because of this individual's historic significance and contributions to American business and enterprise, particularly in the field of food and beverage products. Consumers of packaged combinations containing fresh fruit are likely to maintain a positive association between Applicant's MOTT'S-branded food products and Samuel R. Mott's reputation as a pioneer in the manufacture of applesauce and apple-based products. Consequently, the purchasing public "almost exclusively associate" the term MOTT'S with the famed Samuel R. Mott and Applicant's Mark is "not considered primarily merely a surname." *Lucien Piccard Watch Corp. v. Crescent Corp., 314 F.Supp. 329, 165 USPQ 459 (S.D.N.Y.* 1970*)*.

4. Applicant's prior registrations

It should be noted that Applicant owns ten (10) separate trademark registrations on the Principal Register for the MOTT'S Mark, alone and in combination with other terms, none of which cite a §2(f) claim to acquired distinctiveness. (*See* Request for Reconsideration at **EXHIBIT C**). These registrations claim a broad variety of goods in Classes 18, 29, 30, 32, and 35. Just as these other MOTT'S trademarks have been afforded protection on the Principal Register without a §2(f) claim to acquired distinctiveness, Applicant's Mark deserves similar consideration.

The Examiner notes that "four prior Registrations of the Applicant" for the MOTT'S mark entered the Principal Register pursuant to a §2(f) claim to acquired distinctiveness. Denial of Reconsideration at 3. Applicant responds by further noting that one of these registrations, US Reg. No. 802,371 was registered in 1966. It is unclear whether the MOTT term had surname significance in 1966, but in the intervening forty-six (46) years, the demographic makeup of the United States, and the attendant significance of surnames within the country, has dramatically changed. Any purported admission of acquired distinctiveness has therefore dissipated over the past, near half-century. With respect to the other three registrations cited by the Examiner, Applicant urges that the Board consider the totality of Applicant's portfolio of MOTT'S marks, and in particular the aforementioned ten (10) MOTT'S registrations owned by Applicant which do not contain a §2(f) claim.

5. Examiner's burden has not been met.

It is clear that the burden is on the Examiner to prove that the Mark is primarily merely a surname. *See In re Standard Electrik Lorenz Aktiengesellschaft*, 54 CCPA 1043, 1047, 371 F.2d 870, 873, 152 USPQ 563, 566 (1967). Applicant respectfully submits that the Examiner has not met this burden. Moreover, on the question of whether a mark would be perceived as primarily merely a surname, any doubts should be resolved in favor of Applicant. *See In re Benthin, supra*. Applicant further urges that the preceding arguments have, at the very least, raised doubts about the surname

significance of the Mark that should be resolved in Applicant's favor. In sum, Applicant requests registration of the Mark on the Principal Register *without* a claim to acquired distinctiveness

B. Conclusion

In light of the foregoing arguments and attachments, Applicant respectfully submits that the application is now in condition for allowance on the Principal Register without a §2(f) claim to acquired distinctiveness, and such is earnestly requested.

Respectfully submitted,

Dated: November 5, 2012

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